

09/164,216

PATENT

Petition to Review Withdrawal of Claims

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Ronald Pasqualini

Appln. No.: 09/164,216

Filed: September 30, 1998

For: ESD PROTECTION CIRCUIT UTILIZING
FLOATING LATERAL CLAMP DIODES

Group Art Unit: 2811

Examiner: O. Nadav

PETITION TO REVIEW WITHDRAWAL OF
CLAIMS**CERTIFICATE OF MAILING**I hereby certify that this correspondence is being deposited with the
United States Postal Service, postage prepaid, in an envelope,addressed to Box AF Commissioner for Patents,
Washington D.C. 20231-9999 on July 9, 2002Dated: 07-09-02 By: Salun L. KingCommissioner for Patents
Washington, D.C. 20231

Dear Sir:

1. On September 4, 2001, applicant filed an amendment in the above-identified application. In the amendment, applicant added new claims 38-44. New claims 40-44 were dependent claims that directly or indirectly referred back to independent claim 15, a claim that was under examination in the application.
2. In the final office action mailed October 18, 2001, the Examiner withdrew claims 40-44 as being drawn to a non-elected subcombination, there being no allowable generic or linking claim.
3. In the amendment filed on January 16, 2002, applicant traversed the Examiner's withdrawal of claims 40-44. Applicant argued that restriction is proper when two or more inventions are claimed in a single patent application. A dependent claim includes all of the limitations of its independent claim. As a result, it is not possible for a dependent claim and its independent claim to be directed to two different inventions. Since it is not possible for two or more inventions to be present in the present case, claims 40-44 may not properly be restricted out. As a result, applicant requested that claims 40-44 be reinstated.
4. In the office action mailed February 7, 2002, the Examiner argued that an independent claim and a dependent claim that refers back to the independent claim can be

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restricted if the independent and dependent claims can be related as a combination and a subcombination.

5. In the amendment filed on May 7, 2002, applicant noted that two independent claims can be restricted if the two independent claims are related as a combination and a subcombination. However, a dependent claim and its independent claim may not be properly be restricted because it is not possible for a dependent claim to be directed to an invention that is different from the invention claimed in its independent claim.

6. In the final office action mailed June 25, 2002, the Examiner held the withdrawal of claims 40-44 to be final.

7. As a result, applicant petitions for review of the Examiner's final holding that dependent claims 40-44 can be directed to an invention that is different from the invention claimed by independent claim 15, from which claims 40-44 directly or indirectly depend, and respectively requests that claims 40-44 be reinstated.

Respectfully submitted,

Dated: 7-8-02By: Mark C. Pickering

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